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10/765,512

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Edward Snow Willis II

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07/31/2006

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EXAMINER

KIMBALL, MAKAYLA T

ART UNIT

PAPER NUMBER

2194

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,512

Applicant(s)

WILLIS, EDWARD SNOW

Examiner

Makayla Kimball

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 12 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input checked="" type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>02/23/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are pending and are considered below.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The full name of each inventor (family name and at least one given name together with any initial) has not been set forth.

37 CFR 1.63. Oath or declaration.

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;

The oath or declaration is defective because: The applicant did not provide a full signature.

Specification

3. The disclosure is objected to because of the following informalities: In figure 1, applicant fails to disclose "SIM/RUIM", number 144 in the specification; numerous spelling and grammatical errors throughout the specification and claims i.e. "systemis" on page 5 line 9, "18the" on page 5 line 18, etc.; and In the specification traditional management and dynamic management were not explained.

Appropriate correction is required.

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Claim Objections

4. Claims 4, 7, 12 and 15 are objected to because of the following informalities: In claims 4 and 12 the word "previous" is misspelled and claims 12 and 15 are objected to as failing to provide proper antecedent basis for "NV".

Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where at patent application claim to a genus is anticipated by a patent claim to a species within that genus)." *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "**anticipated**" by the species of the patented invention. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. *In re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (*In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993))

6. Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10-11 of copending Application No. 10/765511. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-8 and 10-11 of Application No. 10/765511 contains every element of claims 1-11 of the instant application and thus anticipate the claims of the instant application. Looking at claim 1 in both applications, both claim checking to see if unique identifier exists and if it does exist to compare unique identifier with software identifier. Both also claim if unique identifier is different or does not exist to update and write software identifier to unique identifier, however, application 10/765512 doesn't say how the changes are received so it would be obvious from application 10/765511 that updates would be received through a network; as shown by the wireless communication device in claim 10 and in the specification of application 10/765512. It is also obvious that the dependent claims of both applications are the same. Claims of the instant application therefore are not patently distinct from the earlier patent claims and such are unpatentable over obvious-type double patenting. A later application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claim 7 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "NV management policies" were never defined in the specification, for examination purposes the examiner will assume applicant meant the "rules" specified on page 7.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-15 are rejected under 35 U.S.C. 101. Claims 1, 9 and 10 are rejected under 101 because if-else statement is not complete. Applicant does not specify what would happen when the unique identifier and the software identifier are similar. Claims 2-8 and 11-15 are being rejected under 35 U.S.C. 101 as being dependent upon independent claims 1 and 10.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

12. Claims 1, 3-10, 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Birum et al (US PG PUB 2003/0221189).

Claim 1:

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A method of dynamically managing non-volatile memory items in a wireless device, said method comprising the steps of:

Checking the non-volatile memory items for a unique identifier item; [0029]

If said unique identifier exists, comparing an identifier stored within said unique identifier item with a software identifier located in software on said wireless device; and [0006, 0029]

If said unique identifier item does not exist or if said identifier is different from said software identifier, performing the steps of: [0030, 0039]

Updating said non-volatile memory items; and [0045]

Writing said software identifier to said unique identifier item. [0045]

Claim 3:

The method of claim 1, wherein said writing step is performed after said updating step is complete. [0009, 0045]

Claim 4:

The method of claim 1, wherein said updating step allows rollback to a previous software version. [0006, 0045]

Claim 5:

The method of claim 4, wherein said updating step preferably creates a new non-volatile memory item rather than replacing an existing non-volatile memory item to facilitate rollback to said existing non-volatile memory item. [0043, 0045]

Claim 6:

The method of claim 5, wherein said updating step does not delete non-volatile memory items that have previously been created. [0043, 0045]

Claim 7:

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The method of claim 6, wherein non-volatile memory items managed under other NV management policies are not updated in said updating step. [0038]

Claim 8:

The method of claim 5, wherein software on said wireless device includes a mapping from old non-volatile memory items to new non-volatile memory items. [0045]

Claim 9:

A method for dynamically managing non-volatile memory items on a wireless device, said method allowing rollback to previous versions of software using said non-volatile memory items, said method comprising the steps of:

Checking the non-volatile memory items for a unique identifier; [0029]

If said unique identifier item exists, comparing an identifier stored within said unique identifier item with a software identifier located in software on said wireless device; and [0006, 0029]

If said unique identifier item does not exist or if said identifier is different from said software identifier, performing steps of: [0030, 0039]

Updating said non-volatile memory items, said updating step:

Creating a new non-volatile memory item rather than replacing an existing non-volatile memory item to facilitate rollback; [0043, 0045]

Retaining non-volatile memory items that have previously been created; and [0043, 0045]

Avoiding non-volatile memory items created by default or refurbished non-volatile memory files; and [0045]

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Writing said software identifier to said unique identifier item, whereby said creating, retaining, and avoiding steps in said updating step allows rollback to previous versions of software on said wireless device. [0045, 0034]

Claim 10:

A wireless communication device comprising:

A receiver for receiving signals; [0051]

A transmitter for transmitting signals; [0051]

A digital processor for processing signals to be sent on said transmitter and received on said receiver; [0051]

A microprocessor communicating with said digital signal processor; [0054]

Non-volatile memory having program storage and non-volatile memory items, said non-volatile memory communicating with said microprocessor; and [0042]

Input and output subsystems interacting with said microprocessor, wherein said microprocessor [0045]

Includes means for checking said non-volatile memory items for a unique identifier item, [0029]

Comparing an identifier stored within said unique identifier item with a software identifier located in software in said program storage if said unique identifier exists;

And if said unique identifier item does not exist or if said identifier is different from said software identifier, means for performing the steps of: [0030, 0039]

Updating said non-volatile memory items; and [0045]

Writing said software identifier to said unique identifier item. [0045]

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Claim 12:

The wireless device of claim 10, wherein said updating means allows rollback to previous software version. [0006, 0034]

Claim 13:

The wireless device of claim 12, wherein said updating means preferably creates a new non-volatile memory item rather than replacing an existing non-volatile memory item to facilitate rollback to said existing non-volatile memory item. [0043, 0045]

Claim 14:

The wireless device of claim 13, wherein said updating means does not delete non-volatile memory items that have previously been created. [0043, 0045]

Claim 15:

The wireless device of claim 14, wherein non-volatile memory items managed under other NV management policies are not updated by said updating means. [0038]

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.
Ascertaining the differences between the prior art and the claims at issue.

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Resolving the level of ordinary skill in the pertinent art.
Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birum et al (2003/0221189) in view of Moore et al (2002/0078142).

Claim 2:

Birum discloses the method as in claim 1 above, but does not disclose the unique identifier and software identifier as being version numbers. Moore does disclose a similar method as in claim 1 and in addition the identifiers are version numbers. Birum and Moore are in the same field of endeavor so it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compare version numbers in order to insure comparing not only the same software but also the same version of the software.

Claim 11:

Birum discloses the method as in claim 10 above, but does not disclose the unique identifier and software identifier as being version numbers. Moore does disclose a similar method as in claim 1 and in addition the identifiers are version numbers. Birum and Moore are in the same field of endeavor so it would have been obvious to a person of ordinary skill in the art at the time the invention was made to compare version numbers in order to insure comparing not only the same software but also the same version of the software.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Roush (US PGPUB 2004/0216133) discloses a method and a system for software upgrades with multiple versions.

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Gentoo Linux Documentation – Portage manual discloses updating and having multiple versions.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Makayla Kimball whose telephone number is 571-270-1057. The examiner can normally be reached on Monday - Thursday 10AM - 3PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Myhre James can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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07/21/2006


James W. Myhre
Supervisory Patent Examiner